

35 U.S.C. §103 Rejection: A Prima Facie Case Not Established

Claims 1, 2 and 4 have been rejected under 35 U.S.C. §103 as being unpatentable over United States Patent No.3, 303,582 to Farquhar.

Claim 3 has been rejected as being unpatentable over Farquhar in view of Wang (U.S. Patent No. 6,039,453).

The courts have established the legal concept of *prima facie* obviousness and the initial burden of factually supporting any *prima facie* conclusion of obviousness rests on the Examiner. To properly establish a *prima facie* case of obviousness, three basic requirements must be met. First, there must be some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all of the claimed limitations. See MPEP § 2143.

Rejection of Claims 1,2, and 4 Improper Since Farquhar Teaches Away

It is a well-established "general rule" that references that teach away cannot serve to create a *prima facie* case of obviousness. In re Gurley, 27 F3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994). A "reference will teach away if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant." Winner Int'l Royalty Corp. v. Wang, 53 USPQ 1580, 1587 (Fed. Cir. 2000) citing Gurley at 1131. A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the Applicant..." Tec Air, Inc. v. Denso, 52 USPQ2d 1294, 1298 (Fed Cir. 1999).

Farquhar '582 patent clearly teaches away from the proposed modification of having an image projected onto an inner surface of an outer cover. It has been asserted by the Examiner that Figure 9 of the Farquhar '582 patent teaches or suggests

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an "image is projected onto an inner surface of the outer cover and is visible from outside the outer cover". Applicant respectfully submits that this assertion is incorrect. Farquhar clearly shows and describes the arrangement of a "star globe 20" and an "Earth globe 100" within the star globe. Farquhar, column 4, lines 63-7. This arrangement teaches projecting an image of "the Earth's continents AND (emphasis added) stars on the viewing surface". Farquhar, column 5, lines 13-15. This viewing surface is clearly not the star globe, since the star globe has the stars on its surface. It is clear that a person of ordinary skill, upon reading the reference, would be led in a direction divergent from the path that was taken by the Applicant in having at least an image projected onto an inner surface of an outer cover. For at least this reason, a rejection under 35 U.S.C. §103 is improper.

Rejection of Claims 1, 2, and 4 Lack Proper Motivation or Suggestion to Modify

It has been repeatedly held that when a single prior art reference is alleged to render the claimed invention obvious, there must be a sufficient showing of a suggestion or motivation for any modification of the teachings of that reference necessary to reach the claimed invention in order to support the obviousness conclusion. Sibia Neuroscis., Inc. v. Cadus Pharm. Corp., 225 F.3d 1349, 1356, 55 USPQ2d 1927, 1931 (Fed. Cir. 2000); B.F. Goodrich Co. v. Aircraft Braking Sys. Corp., 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996). This suggestion or motivation may be derived from the prior art reference itself, from the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. Sibia, 225 F.3d at 1356, 55 USPQ2d at 1931.

A rejection of Claim 1 under 35 U.S.C. §103 has not been properly established since there is no motivation or suggestion to modify the reference of Farquhar. Farquhar does not teach or suggest, at least, an image being projected onto an inner surface of an outer cover. Farquhar instead teaches and suggests projecting images from both an inner and outer globe to a third surface. Farquhar, column 5, lines 13-15. For at least this reason a rejection under 35 U.S.C. §103 is improper.

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Rejection of Claims 1,2 and 4 Improper Due to Lack All Claimed Elements


A prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP §2143. As discussed above, Farquhar does not teach or suggest, at least, an image being projected onto an inner surface of an outer cover. Farquhar as discussed above instead teaches projecting images from both an inner and outer globe to a third surface. Farquhar, column 5, lines 13-15. As such, a proper *prima facie* case for obviousness has clearly not been established. For at least this reason, a rejection under 35 U.S.C. §103 is improper.

Rejection of Claim 3 Improper

Claim 3 is not properly rejected under 35 U.S.C. §103 for at least the reason that claim 3 depends from claim 1.

In summary, Applicant has addressed each of the rejections within the present Office Action. It is believed the application now stands in condition for allowance, and prompt favorable action thereon is earnestly solicited.

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